APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,881	12/31/2001	Chris E. Kalish	85-CI-106	6441

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EXAMINER
STIMPAK, JOHNNA

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.		Applicant(s)	
Office Action Summary	10/038,881		KALISH ET AL.	
	Examiner		**Art Unit**	
	Johnna R Stimpak		3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _31 December 2001_ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-48_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-48_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _14 August 2002_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

The following is a first Office Action upon examination of application number

10/038881. Claims 1-48 are pending and have been examined on the merits discussed

below.

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   **Claims 3, 4, 24 and 25** are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. It is not clear what is meant by

"disproportionate amount of recent publicity" and "little publicity". This limitation

specifically is not clear just how many times a technology must show up in publications

to be deemed a disproportionate or little amount of publicity since no baseline has been

established.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requires of this title.

4.   **Claims 1-4, 6-11, 14-25, 27-32, 35-42** are rejected under 35 U.S.C. 101 because

the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

In the present case, claims 1-4, 6-11, 14-25, 27-32 and 35-42 recite only the steps of evaluating merits of business opportunities or technologies is performed manually by a human without the aid of any technology and therefore does not apply, involve, use or advance the technological arts.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces an evaluation (useful and tangible) of business opportunities according to specific criteria (concrete).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-4, 6-11, 14-25, 27-32 and 35-42 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6.   **Claims 1-16, 18-20, 22-37, 39-41 and 43-48** are rejected under 35 U.S.C. 102(e)

as being anticipated by Reese, U.S. Patent Number 6,236,980 B1.

As per **claim 1**, Reese teaches identifying a first set of potential business

opportunities of interest to a business from an initial, larger pool of business opportunities

(column 11, lines 46-55 - 12, lines 26-32, 40-50 – recommendations of business

investment opportunities are identified by analyzing over 10,000 recommendations from

sources such as magazines or on-line sources); analyzing the first set of business

opportunities by having a group of persons evaluate them using an elimination tool which

generates a set of data, the data providing for a ranking of the business opportunities in

the first set (column 15, lines 47-64, column 16, lines 45-50 – the group of business

investment opportunities is analyzed by algorithms to construct a subset of ranked

information) ; culling from the first set of business opportunities a reduced second set of

business opportunities having sufficiently high ranking (column 18, lines 5-22 – the

ranking takes place and is reported so the user can make their decision); analyzing the

second set of business opportunities to determine a numerical first characteristic and a

numerical second characteristic for each of them (column 22, lines 10-31 – pain index

and smile index are numbers indicating characteristics (see definitions column 5 and 6);

and providing a graphical representation of the first and second characteristics for at least

some of the business opportunities in the second set (column 23, lines 15-30 and figure

8b smile index and pain index listed on a graphical chart).

As per **claim 2**, Reese teaches the initial, larger pool of business opportunities is

identified by examining publications of interest (column 13, lines 59-63).

As per **claim 3**, Reese teaches the first set of potential business opportunities is

characterized by a disproportionate amount of recent publicity (column 3, lines 38-51 –

business opportunities that are mentioned in publications are reported).

As per **claim 4**, Reese teaches the first set of potential business opportunities is

characterized by little publicity prior to a selected date (column 13, line 59 – column 14,

line 3 – publicity is reviewed during a specific time frame).

As per **claim 5**, Reese teaches web pages are searched for business opportunities

(column 13, lines 5-29)

As per **claim 6**, Reese teaches the elimination tool comprises a set of criteria for

judging the first set of business opportunities (column 14, lines 22-34).

As per **claim 7**, Reese teaches the criteria include an evaluation of the uniqueness

of the opportunity (figure 7 shows that the uniqueness of an opportunity is taken into

account for the recommendation. The article summarization presents the uniqueness of

the company, for example, the summary lists a company as the best theme park provider).

As per **claim 8**, Reese teaches the criteria include an evaluation of the advantages

of the business opportunity over other business opportunities (column 24, lines 33-45 –

comparison of the opportunity to a benchmark).

As per **claim 9**, Reese teaches each of the business opportunities is evaluated by each of the persons (column 13, lines 20-29 – the user receives the report and use it to make a decision on the evaluation of the business opportunities).

As per **claim 10**, teaches each person provides a score for each of the criteria for every business that the persona evaluates (figure 4 shows stars next to the recommendor's name, these stars portray the recommendor's score of the opportunity).

As per **claim 11**, Reese teaches the elimination tool provides a statistical summary of the numerical ranking (column 16, lines 45-50).

As per **claim 12**, Reese teaches a computer is used to collect and analyze the data generated by use of the elimination tool (column 11, lines 40-55).

As per **claim 13**, Reese teaches a computer is used to determine the first and second characteristics (column 22, lines 10-42 – the pain index and smile index are determined by use of the Microsoft Access query performed on the computer).

As per **claim 14**, Reese teaches the first numerical characteristic is a measure of the usability of the business opportunity (column 6, lines 56-63 – the smile index is an indication of the pleasantness of the usability of the recommendation).

As per **claim 15**, Reese teaches the second numerical characteristic is a measure of the ease with which the opportunity can be acquired (column 5, lines 42-47 – the pain index describes the stress or unpleasantness that goes along with the following the recommendation).

As per **claim 16**, Reese teaches the numerical first and second characteristics are determined by evaluating a business opportunity according to first and second sets of

criteria (column 5, lines 42-47 and column 6, lines 56-53 – the pain index and smile

index describe characteristics of the business opportunity numerically).

As per **claim 18**, Reese teaches the numerical values of the first and second

characteristics determine whether the business opportunity is one that should be pursued

by an approach selected from the group consisting of adoption, partnering and investing

(column 5, line 63 – column 6, line 16 – the recommendation includes advice such as

purchase, buy, pick, strong interest indicating if the business opportunity should be

pursued).

As per **claim 19**, Reese teaches the numerical values of the first and second

characteristics are plotted on a graph (column 14, lines 52-60 – the data is reported in the

form of rows, columns and fields).

As per **claim 20**, Reese teaches the graph is in a form of a matrix (column 14,

lines 52-60 – the data is reported in the form of rows, columns and fields (figure 4 is a

matrix)).

As per **claims 22-37 and 39-41**, they are directed to the same method as claims 1-

16 and 18-20. The only difference is in the preamble where claims 1-16 and 18-20 are

directed to evaluating business opportunities and claims 22-37 and 39-41 are directed to

evaluating technologies. Since new technology can be considered as a new business

opportunity, the same rejection as applied to claims 1-16 and 18-20 is applied to claims

22-37 and 39-41.

As per **claim 43**, Reese teaches an apparatus with means for identifying a first set of potential technologies of interest to a business from an initial, larger pool of technologies (column 12, lines 40-50 – automated process of searching over 10,000 recommendations from sources such as magazines); means for analyzing the first set of technologies by having a group of persons evaluate them using an elimination tool which generates a set of data, the data providing for a ranking of the technologies in the first set (column 16, lines 11-20, 35-50); means for culling from the first set of technologies a reduced second set of technologies having sufficiently high ranking; means for analyzing the second set of technologies to determine a numerical first characteristic and a numerical second characteristic for each of them (column 22, lines 10-31 – pain index and smile index are numbers indicating characteristics (see definitions column 5 and 6)); and means for providing a graphical representation of the first and second characteristics for at least some of the technologies in the second set (column 23, lines 15-30 and figure 8b smile index and pain index listed on a graphical chart).

As per **claim 44**, Reese teaches the means for identifying a first set of potential technologies comprises a computer (column 11, lines 40-55).

As per **claim 45**, Reese teaches the means for analyzing the first set of technologies comprises a set of numerically gradable criteria provided to the persons (column 22, lines 10-31 – pain index and smile index are numbers indicating characteristics (see definitions column 5 and 6)).

As per **claim 46**, Reese teaches the means for culling from the first set of technologies a reduced second set of technologies comprises a computer (column 14, lines 22-34 – the user can reduce the number of technologies down to a specific one).

As per **claim 47**, Reese teaches the means for analyzing the second set of

technologies comprises both human judgment and machine calculation (column 13, lines

20-29 – computer algorithms are used to report the data to the user so the user can make a

more informed decision).

As per **claim 48**, Reese teaches the means for providing a graphical representation

comprise a matrix (column 14, lines 52-60 – the data is reported in the form of rows,

columns and fields (figure 4 is a matrix)).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   **Claims 21 and 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Reese, US Patent No. 6,236,980 B1.

As per **claims 21 and 42**, Reese teaches a matrix including a recommendation

column, but does not specifically teach the matrix is divided into nine rectangles which

are labeled by at least one of the words adopt, partner, invest and ignore. In figure 8C of

Reese, the matrix shown has a column for a recommendation such as buy, pick, pan,

invest, etc. (more examples are shown in column 6, lines 4-16). The matrix in Reese and

the matrix in this specification both portray the same recommendation information. The

number of rectangles in the matrix is dictated by the criteria used to evaluate the

opportunity, therefore there is no patentable significance to the specific number of

rectangles in the matrix. Official notice is taken that it is old and well known in the art of

decision making to chart the results of the decision process and list recommendations.

Therefore it would have been obvious to one of ordinary skill in the art to format a matrix

to show recommendations. This gives the user an easy-to-read table that enables the user

to quickly determine whether or not to follow the recommendation.

Conclusion

9.　　　The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Breitzman et al, US Patent No. 6,175,824 B1 – method and apparatus for choosing a

stock portfolio based on patent indicators

Armstrong et al, US Patent No. 5,627,973 – method and apparatus for facilitating

evaluation of business opportunities for supplying goods or services to potential

customers.

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to **Johnna Stimpak** whose telephone number is **703-305-**

4566. The examiner can normally be reached Monday through Friday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, **Tariq Hafiz**, can be reached on **703-305-9643**.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the **Receptionist** whose telephone number is **703-308-**

1113.

Any response to this action should be mailed to:

> Commissioner of Patents and Trademarks
> Washington, D.C. 20231

Or faxed to:

703-305-7687	[Official communications; including After Final communications labeled "Box AF"]
703-746-3956	[Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal

Drive, Arlington, VA, 7th Floor.

3/19/03
JS

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